



IPW

Docket No.: 1793.1234

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Joo-ho KIM et al.

Serial No. 10/813,619

Group Art Unit: 2818

Confirmation No. 3826

Filed: March 31, 2004

Examiner: Dung Anh LE

For: RECORDING MEDIUM HAVING SUPER-RESOLUTION NEAR-FIELD STRUCTURE
AND METHOD AND APPARATUS FOR REPRODUCING THE SAME

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed June 22, 2005, having a shortened period for response set to expire on July 22, 2005, the following remarks are respectfully submitted.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I, claims 1-19, drawn to a semiconductor device, in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Group II is concerned, it is believed that claims 20-30 are so closely related to elected claims 1-19 that they should remain in the same application. The elected claims 1-19 are directed to a semiconductor device and claims 20-30 are drawn to a method of making the semiconductor device. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. While it is noted that the Examiner has identified different classifications for the product and method claims, it is believed that classification is not conclusive on the question of restriction. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by the Group II claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Even if the Examiner considers claims 20-30 to be a separate invention from claims 1-19, the Applicants respectfully request the Examiner to consider claims 20-30 (Group II) and claims 1-19 (Group I) together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the method recited by the Group II claims is directed to a semiconductor device, and elected claims 1-19 are directed to the semiconductor device, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, all of the pending claims should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 503333.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 7/21/05

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